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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,751	12/18/2000	Hiroshi Yanagawa	2000-1713	2790

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EXAMINER
PROUTY, REBECCA E

ART UNIT	PAPER NUMBER
1652	3

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/737,751	Yanagawa et al.
Examiner	**Art Unit**
Rebecca Prouty	1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 13-22 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 13-22 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/190,276.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claims 1-12 have been canceled. Claims 13-22 are at issue and are present for examination.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,228,994. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*

Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13-20 are generic to all that is recited in claims 1-8 of U.S. Patent No. 6,228,994. That is, claims 1-8 of U.S. Patent No.6,228,994 fall entirely within the scope of claims 13-20 or, in other words, claims 13-20 are anticipated by claims 1-8 of U.S. Patent No.6,228,994. Specifically, the labeled protein of Claims 1-8 of U.S. Patent No.6,228,994 differs form the labeled protein claimed only in that the protein of the previous patent **consists of** a protein portion and a labeling compound while the labeled protein of the current claims **comprises** a protein portion and the same labeling compounds recited by the patent. Furthermore, while the previous patent does not specifically claim the labeling compound of current claims 21-22 itself it would have been obvious to one of ordinary skill in the art from the labeled protein of Claims 1-8 of the patent as it is a necessary component for making the labeled protein of the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country,

> more than one year prior to the date of application for patent in the United States.

Claims 13-15, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Vince et al.

Vince et al. teach a photoaffinity (i.e., non-radioactive) labeling puromycin analogue N^{ϵ}-(2-nitro-4-azidophenyl)-L-lysinyl puromycin aminonucleoside (NAP-Lys-PAN) and labeled protein produced linked to said label. This anticipates all of Claims 3-15 and 20-22.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemoto et al. (Reference AQ of applicant's PTO-

1449) in view of Promega Technical Bulletin No. 182 (Reference AO of applicant's PTO-1449).

Nemoto et al. teach the compound ^{32}P-rCpPur, an *in vitro* virus genome with ^{32}P-rCpPur attached at the 3' end and proteins labeled with the *in vitro* virus genome at their C-terminal ends during cell-free protein synthesis. The labeled proteins and labeling compound of Nemoto et al. differs from that claimed only in that the label is radioactive while applicants claims recite a non-radioactive label.

Promega Technical Bulletin No. 182 teach the advantages of using non-radioactive labels include no storage and disposal problems and no decay of the label with time.

Therefore, it would have been obvious to one of ordinary skill in the art to replace the ^{32}P label in the ^{32}P-rCpPur with any known non-radioactive label such as the biotin label used by Promega which can be easily detected in order to avoid storage and disposal problems and the decay of the ^{32}P label with time. Furthermore, while Promega teaches one type of non-radioactive label, i.e. biotin, many others are known in the art including fluorescent compounds such as fluorescein, and many colored dyes or enzyme substrates detectable by colorimetric methods. Use of

any such non-radioactive label would have been obvious to one of ordinary skill in the art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Szostak et al. teach methods virtually identical to those taught by Nemoto et al. and further teach other suitable peptide acceptor compounds include any compound which possesses an amino acid linked to an adenine or adenine-like compound (see column 12).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Rebecca Prouty
Primary Examiner
Art Unit 1652